

REMARKS

With this Response, claim 40 is amended to include the features of claim 41. Claim 41 is canceled and claim 42 is amended to change the dependency accordingly. No new matter is added, and no further searching should be warranted since claim 41 was previously presented and presumably searched. After entry of the above amendments, claims 40, 42-47, 49-62 and 85-89 are pending and presented for examination.

Applicant specifically reserves the right to pursue the subject matter of the canceled or amended claims in a related application. Each of the rejections levied in the Office Action is addressed individually below.

Rejections under 35 U.S.C. § 103(a) for obviousness

Claims 40-47, 49-62 and 85-89 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the sole lost count of Patent Interference No. 105,406 in view of U.S. Patent No. 6797313 ("Fritzemeier") and U.S. Patent No. 6172009 ("Smith").

As amended, the claims in the present application recite a method of producing an oriented oxide superconducting film, wherein the total pressure is less than about 8 Torr. The newly added features in claim 40 are supported by the originally-filed, now-canceled claim 41 and by the present specification, for example, on page 3, line 20, on page 4, line 7, and on page 10, line 2.

The lost count discloses a method of forming a film of crystalline $\text{YBa}_2\text{Cu}_3\text{O}_7$. The Examiner states that the lost count teaches the pressure in claims 41 and 42 (see, Office Action, page 5). The Examiner further asserts that "the subject matter of the lost count requires that the [total] pressure is 0.3 Torr or less." Applicant disagrees.

As an initial matter, Applicant respectfully reminds the Examiner that since the language of the lost count is unambiguous, it is improper to resort to the specification from which a count originated to construe the count. *See, e.g., Noelle v. Lederman*, 355 F.3d 1343, 1350-51 (Fed. Cir. 2004); *Reece v. Hurst*, 661 F.2d 1222, 1236 (C.C.P.A. 1981).

The lost count recites:

143. A method of forming a film of crystalline $\text{YBa}_2\text{Cu}_3\text{O}_7$ comprising:
forming a precursor film comprising barium (Ba), fluorine (F), yttrium (Y) and copper (Cu);

heat-treating said precursor film at a temperature above about 700° C in the presence of oxygen and water vapor at a sub-atmospheric pressure to form a crystalline structure; and

annealing said crystalline structure in the presence of oxygen.

The language of the lost count at best discloses sub-atmospheric pressure. The lost count does not teach the total pressure to be less than about 8 Torr as recited in the present claims. Furthermore, neither Fritzemeier nor Smith discloses or suggests a total pressure of 8 Torr or less. Thus, assuming, but not conceding, that the lost count, Fritzemeier and Smith could have been properly combined, the resulting combination could not have arrived at the claimed subject matter.

For at least these reasons above, independent claim 40 and all the dependent claims should be patentable over the lost count in view of Fritzemeier and Smith. Applicant respectfully requests that the rejections be removed.

Conclusion

In light of the above amendments and remarks, each of the rejections in this case should be removed and the application should proceed to allowance.

No fee is believed to be due. To the extent that there are any discrepancies between what Applicant has paid with the filing and/or prosecution of the present Application and what the USPTO believes is owed, please apply any charges or credits to deposit account 03-1721, referencing Attorney Docket No. 0492611-0545 (MIT9277CONII). Applicant respectfully requests that a Notice be issued explaining any such discrepancy.

Respectfully submitted,

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